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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/408,091	09/29/1999	GORDON HOWARD EPSTEIN	GE1610	3584

7590

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EXAMINER

KENNEDY, SHARON E

ART UNIT PAPER NUMBER

3763

DATE MAILED: 03/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/408,091

Applicant
Epstein et al.

Examiner
Sharon Kennedy

Art Unit
3763



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.138 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 30, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above, claim(s) 8, 12-14, and 17 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6, 9, 10, 18, and 19 is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 11, 15, 16, 20, and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action or the MPEP.

Election/Restriction

2. This application contains claims 8, 12-14, 17 drawn to an invention nonelected with traverse in Paper No. 13. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 112

3. Claims 1-5, 7, 11, 15, 16, 20 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claims 1, 20 and 21, these claims state that the mixing volume is "at a distal end" of the dual catheter and further require that the mixing occur "prior to discharge from the distal end of the catheter." This is confusing since it is unclear if the embodiment of Figure 1 is being claimed, wherein the mixing volume is within the distal end, or if the patent to Coelho et al., US 5,975,367, would anticipate the claims. This is important because this idea defined the point of novelty for allowed claims 6, 9, 10, 18 and 19, directed to a mixing volume "within" the catheter. Further regarding claim 2, claim 2 is directed to the dual catheter, which is now claimed in claim 1.

Claim Rejections - 35 USC § 102

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Mammolenti et al., US 4,601,697. See the comments set forth in the previous office action.
5. Claims 1, 2, 7 and 19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Redl '055. See the comments set forth in the last office action.
6. Claims 1, 2, 7, 20 and 21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Coelho et al., US 5,975,367. The fibrin glue is mixed at the distal end exit 19. Thereafter, the glue leaves the end 19 of the dispenser and is thus "discharged from the distal end" of the dispenser, meeting the elements of applicant's claims.
7. Claims 1, 3, 4 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Hasson, US 4,935,006. See the comments set forth in the previous office action.

Claim Rejections - 35 USC § 103

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Redl, US 4,631,055. The claimed clearing system has few limitations and is more like a statement of function. The examiner submits that a moistened paper towel or the like, combined with the Redl device, would anticipate claim 5. It would be obvious to clean the head of Redl since the ordinary consumer typically wipes the head of an adhesive dispenser during use and before storage. For example, most consumers would clean the tip of their Elmer's glue bottle before reapplying the cap, or during application if the tip became too messy.

9. Claims 11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hasson, US 4,935,006. Regarding claim 11, it would be obvious to add graduated markings if necessary. Regarding claim 15, the cap is an obvious design choice and probably included on these suction and irrigation devices during sale.

Response to Arguments

10. Applicant's arguments filed December 30, 2002 have been fully considered but they are not persuasive.

11. In response to applicant's argument that neither Mammolenti nor Hasson disclose the dispensing of adhesive, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

12. In response to applicant's arguments that Redl '005 does not disclose a mixing volume, the catheter 31 clearly serves as a mixing volume at the distal end.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

14. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon Kennedy whose telephone number is (703) 303-0154.

March 19, 2003

Sharon Kennedy
Sharon Kennedy
Primary Examiner